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using the solidified material in the construct of a product.

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27. The method of claim 26 wherein the molten or semi-molten material is a plastic.
28. A process for ascertaining whether an item having a unique item identifier in electrically-readable coded form, said unique item identifier identifying the manufacturer of said item and comprising information specific to said item, is the same item that is identified by information in electronically-readable coded form on a medium, said process comprising the steps of:
- a) comparing said unique item identifier on said item with the electronically-readable coded form information on said medium;
- b) determining that said item having said unique item identifier is the same as said item identified on said medium if the unique item identifier favorably compares with the electronically-readable coded form information of step a.
29. The product of claim 18 wherein said package identifier further comprises information pertaining to characteristics of the item.
30. The product of claim 29 wherein said package identifier comprises information pertaining to the dimensions or features of the item.
31. The product of claim 29 wherein said package identifier comprises information pertaining to add-ons associated with the item.
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REMARKS

STATUS OF PENDING CLAIMS AFTER INCORPORATION OF CHANGES

Claims 8, 9, 10 – 12, 13 - 14, 15 – 17, 18, 19 – 21, 26 - 27 and 28 - 31 are now pending in the application. Claims 8, 10 – 12, 15, 17, and 19 - 21 are amended herein. Claims 28 – 31 are new. Support for new claims 28 – 31 is found, among other places at pages 8 – 9,

and Fig. 4 of the specification. Claims 8, 15, 21, 26 and 28 are independent claims. Claims 9 – 14 ultimately depend from claim 8, claims 16 – 20 and 29 – 31 ultimately depend from claim 15, and claim 27 ultimately depends from claim 26.

DIRECTED RESPONSE TO THE OFFICE ACTION OF OCTOBER 4, 2002

RESPONSE TO REJECTIONS

In the Claims:

- **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**
 - **The Examiner's Position:**

The Examiner has rejected claim 7 under 35 U.S.C. §112, second paragraph. Such rejection is believed to be actually directed to claim 17 (there is no claim 7). The Examiner asserts that the limitation “the lot” in line 2 of the claim has insufficient antecedent basis, and therefore argues that the claim is indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention embodiment.

Applicant's Position:

Applicant respectfully traverses the Examiner's position on the basis that a person of ordinary skill in the art would understand the claims as drafted as particularly pointing out and distinctly claiming the subject matter thereof. However, in order to expedite prosecution in this case, Applicant has amended claim 17 to positively recite a “lot” prior to its use in the second line of the claim. Applicants believes that the amended claim overcomes any antecedent basis problem that may have existed. Applicant therefore respectfully requests that the Examiner withdraw his 35 U.S.C. §112, second paragraph, rejection of claim 17.

- **Claim Rejections under 35 U.S.C. § 102(e):**
 - **The Examiner's Position:**

The Examiner has rejected claims 22 – 25 as being anticipated by U.S. Patent No. 5,970,469 to Scroogie *et al.* (the “Scroogie *et al.* reference”).

The Examiner asserts that "Scroogie teaches a computer-assisted method of purchase" wherein "a purchaser uses an identity card to purchase a good" (page 3, section 6, of the Office Action). The Examiner reasons that the "card would contain information, possibly pointing to an email address of the customer" (emphasis added) (*Id.*). The Examiner further asserts that the reference teaches that when "an identifier on the good is scanned by a scanner ... the good is correlated with the customer in a database" (*Id.*). The Examiner further asserts that the reference teaches that "[s]econdary purveyors, such as retailers or supermarkets are able to access the characteristics of the goods and offer discounts, coupons, or services based on the goods purchased by the customer" and that "[s]uch offers would provide an address as to where to used [sic] these discounts or services" (*Id.*). The Examiner states that "[t]hese purchases and offers would be available via [the] Internet" (*Id.*).

- **Applicant's Position:**

Applicant traverses the Examiner's rejection of claims 22 – 25 on the basis that the Examiner has failed to show that each and every limitation found in the claims is found in the prior art of record. For example, the Applicant particularly argues that the Examiner has failed to demonstrate that the Scroogie *et al.* reference discloses a database that correlates a good with one or more associated characteristics of a good, and a relational database correlating the associated characteristics of goods with offers by secondary purveyor(s) proffering good or services directed to such associated characteristics. While Applicant asserts that the Examiner's rejection is not supported by the Scroogie *et al.* reference, Applicant has cancelled such claims, in lieu of prosecuting such claims (or claims covering similar subject matter) in a subsequent priority filing. Such cancellation is made in order to streamline prosecution of the case at bar by limiting the claims to embodiments of present commercial interest to the Applicant. Cancellation is made without prejudice. It is asserted that cancellation of the claims obviate such 35 U.S.C. §102(e) rejection.

- **Claim Rejections under 35 U.S.C. § 102(b):**

- **The Examiner's Position:**

The Examiner has rejected claims 26 – 27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,822,973 to Fahner *et al.* (the “Fahner *et al.* reference”) (page 3, section 8, of the Office Action). The Examiner asserts that the Fahner *et al.* reference “teaches a method for encoding concealed identifier on an item, the method includes directing electromagnetic laser beams from laser 10 to a molten plastic material 14 on a part, the beams forming a unique identifier (see figures 3 and 4 and col. 4, lines 24 – 29)”.

- **Applicant’s Position:**

Applicant respectfully traverses the Examiner’s rejection of claims 26 – 27 under 35 U.S.C. §102(b), in part on the basis that (as iterated at interview) the Fahner *et al.* reference does not teach or suggest directing the waves at a material in a molten or semi-molten state. Applicant argues that the recitation in the Fahner *et al.* reference to a “thermoplastic” would not suggest to a skilled artisan in the slightest manner that the material should be molten or semi-molten. The term “thermoplastic” rather references a material that is “capable of softening or fusing when heated and of hardening again when cooled” (Webster’s Ninth New Collegiate Dictionary) and is a term used in the plastic art to divide these types of plastics from the so-called thermoset plastics.

Applicant once more points out to the Examiner that in Examiner Tremblay’s April 9, 1997 Office Action, Examiner Tremblay found claim 2, which claim 26 parallels, allowable noting that “the prior art of record fails to teach or suggest the encoding of concealed identifiers while the material is still in a molten or semi-molten state,” and that “while the difficulties in obtaining sufficient laser power are discussed in many of the disclosures, nothing in the prior art suggest treating an article in a molten or semi-molten state” (page 6, lines 9 – 15, of the April 9, 1997 Office Action). The statements were made after the Examiner had reviewed the Fahner *et al.* reference (U.S. Patent No. 4,822,973) (See IDS dated March 24, 1997).

Applicants respectfully requests that the 35 U.S.C. §102(b) rejection of claims 26 – 27 be withdrawn, and the claims re-instated as allowable.

- **Claim Rejections under 35 U.S.C. § 103(a):**

- **The Examiner's Position:**

The Examiner has rejected claims 8 – 11, 12, 13, 14, 15 – 20, and 21 under 35 U.S.C. §103(a). Claims 8 – 11 and 21 stand rejected as being unpatentable over U.S. Patent No. 5,434,394 to Roach *et al.* (the “Roach *et al.* reference”) in view of U.S. Patent No. 5,646,365 to Collier (the “Collier reference”) (page 4, section 10, of the Office Action). Claims 12 and 15 – 20 stand rejected as being unpatentable over the Roach *et al.* reference, as modified by the Collier reference, further in view of U.S. Patent No. 5,592,561 to Moore (the “Moore reference”) (page 5, section 11, of the Office Action). Claims 13 and 14 stand rejected as being unpatentable over the Roach *et al.* reference as modified by the Collier reference, further in view of U.S. Patent No. 5,623,552 to Lane (the “Lane reference”) (*Id.*).

The Examiner has asserted in his Office Action/at interview that the Roach *et al.* reference teaches “a computer assisted method of recording the identity of a purchaser in a retail setting” in conjunction with a universal product code, while the Collier reference is stated to show coded goods enclosed within a package having a bar code correlateable with the code which is identically found on each good (bullet) in the package (page 4 – 5, section 10, of the Office Action). The Moore reference is said to teach “the authentication of a good” where “the code [is] not observable under visible light and can be read under non-visible light” (page 5, section 11, of the Office Action). The Lane reference is said to show that a smart card can be used for self-authentication (page 7, section 12).

Applicant's Position:

Applicant respectfully traverses all of the Examiner’s 35 U.S.C. § 103(a) rejections based in part on the failure of the Examiner to recite adequate motivation for combining the references in the manner indicated, and based in part on the inappropriate use by the Examiner of “hindsight reasoning” in an attempt to “approximate” the present invention.

“Hindsight reasoning” is particularly demonstrated by the rejection of claim 17, which tracks former claims 11 and 19, which were allowed by Examiner Tremblay in the Office Action dated December 2, 1997. At pages 5 – 6 of the December 2, 1997 office action, Examiner

Tremblay allows former claims 11 and 19 based on the following statement for the indication of allowable subject matter: "the prior art fails to teach or suggest changing the location of the marking according to lot number. While it is clear that others have attempted to hide the marking, there is no teaching of systematically varying the location according to lot number in the content of the limitations of claims 9 and 17 from which 11 and 19 respectively depend. The person of ordinary skill in the art would not, in the Examiner's opinion, have any common knowledge of such an arrangement, or motivation to modify the prior art to include this step." Regardless of Examiner Tremblay's expressions as to this matter, the present Examiner now asserts that "[i]t would have been an obvious expedient to have the position of the code as a further indication of the lot the good was presented from ... it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the coded identifier positioned on the good so as to denote a particular lot in which the good was manufactured" (page 6, section 11, of the Office Action).

Respectfully, hindsight reasoning may also be said to be found in the Examiner's statement with respect to the identifiers on the tags of the Collier *et al.* reference to the effect that "[i]t also would be within the realm of the information to contain a manufacturer's data" (emphasis added) (page 8, section 14, of the Office Action), that such identifier "reflects the type of bullet, lot, and manufacture of the bullet" (page 5, section 10, of the Office Action) and the tags have a bar code thereon (page 5, section 10, of the Office Action) without recitation to any specific disclosure in the Collier *et al.* reference supporting these assertions (n.b., Applicant can not find any specific support for these assertions in the reference).

Respectfully, Applicant asserts that the Examiner has failed to provide adequate motivation to combine the references of record in the manner suggested by the Examiner, and then to make the numerous changes that would be necessary to eventuate in the presently claimed embodiments. For example, the Applicant notes that the Roach *et al.* reference is related to "an automated system for integrating point of sale and warehouse processing functions in the selection, order and delivery of merchandise" (See col. 1, lines 9 – 14 of U.S. Patent No. 5,434,394), while the Collier *et al.* reference provides a system for bullet registration (See col. 1, line 48 of U.S. Patent No. 5,434,394). The Examiner fails to provide any cogent motivation for

combining these two disparate references, other it seems, than the fact that both involve the purchase of goods.

Applicant notes, as discussed during the interview, that the art of record does not suggest or disclose an item associated with an unique item identifier, the item identifier identifying the manufacturer of the item and comprising information specific to the item. Such recitation is now specifically set forth in the claims before the Examiner. Further with respect to claim 8 (and therefore with respect to claims 9 -14 which depend there from), claim 15 (and therefore with respect to claims 16 – 20 which depend there from), and claim 21, Applicant notes that the references recited by the Examiner do not disclose an electrically-readable coded form package identifier correlateable with the unique item identifier. Such type of package identifier permits easy correlation of the particular item purchased by purchaser with the purchaser's identity, in particular when an identity card housing electronically-readable personal identification information is tendered in conjunction with the package. Such correlation is particularly useful when an item purchased by a purchaser (e.g. a particular television set, as opposed to a television set product line) is later stolen. Upon retrieval of the item, the purchaser can be found through detection of the unique item identifier.

With respect to claims 10, 11, and new claim 28, it is further asserted that none of the references of record disclose or suggest that information pertaining to the unique product item identifier be placed on a medium, such as a sales receipt or bill of sale, alone or in combination with personal identification information. Nor do the references of record suggest that such information be in electronically readable coded form, or that such medium be used for further recordation of subsequent purchasers of the item.

Applicant respectfully urges the Examiner to reconsider his rejections, in particular in light of the claims presently before the Examiner.

CONCLUSIONS

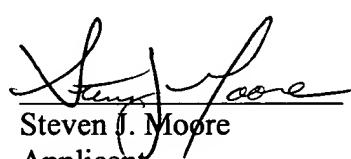
In view of the above, it is respectfully submitted that the subject matter from the pending claims are patentable over the references of record. An early notice of allowance is therefore earnestly requested.

REQUEST FOR, AND PAYMENT OF, ONE-MONTH EXTENSION FEE

Applicant hereby requests a one month extension to the shortened statutory response period be granted. A check for the sum of \$55 is enclosed to cover the same (small entity fee).

Respectfully Submitted,

Date: 2/3/2003


Steven J. Moore
Applicant

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SCHEDULE A

MARKED VERSION OF CLAIM CHANGES

8. (Twice Amended) A computer-assisted method of recording an identity of a purchaser of a particular good-item in a retail setting comprising:

accepting from a purchaser at a point of retail sale a good-an item encoded with a unique product-item identifier, said item identifier identifying the manufacturer of said particular good-item and comprising indicia-information specific to said particular gooditem, said good-item being enclosed in a package having a visible electronically-readable coded form package identifier correlateable with said indicia specific to said particular gooditem;

accepting from said purchaser of said good at a point of retail sale an identity card housing electronically-readable personal identification information;

inputting at the point of sale by an electro-optical reader said personal identification information from said identity card into electronic storage;

inputting at the point of retail sale by an electro-optical reader into said electronic storage said visible electronically-readable coded form package identifier and information pertaining to the manufacturer of said particular gooditem;

correlating said personal identification information with said package identifier and information pertaining to the manufacturer of said particular good-item in a computer database.

9. (Once Amended) The method of claim 8 further comprising the step of transferring said correlated data to a shared database with other retailers.

10. (Twice Amended) The method of claim 8 further comprising the step of: providing at least a portion of said unique product item identifier to the purchaser in electronically readable coded form on a medium ~~for further recordation of a subsequent purchaser of said good.~~
11. (Twice Amended) The method of claim 10 further comprising the step of: printing said package identifier and said personal identification information on a sales receipt in electronically readable coded form ~~at the point of retail sale of said good.~~
12. (Twice Amended) The method of claim 8 wherein the good item identifier is invisible in visible light.
13. (Once Amended) The method of claim 8 wherein the identity card is a self-authenticating electronically-readable coded identity card.
14. (Once Amended) The method of claim 8 wherein the identity card is a microcircuit technology card.
15. (Twice Amended) A process for encoding a product an item with an identifier uniquely correlateable with said productitem:

encoding coding a good an item with an invisible unique product item identifier in electronically-readable coded form, said unique product item identifier identifying the manufacturer of said good item and containing comprising indicia information specifically identifying said gooditem;

on said good item or the packaging of said gooditem, placing a package identifier, in visible electronically-readable coded form, which is correlateable with said invisible unique product item identifier, said package identifier identifying the type of gooditem, the good's item's manufacturer, as well as identifying said indicia on said gooditem.

16. (Twice Amended) The process of claim 15 wherein the invisible encoding of the unique product item identifier is associated with the item is invisibly performed below the surface of a material comprising said good.
17. (Twice Amended) The process of claim 15 wherein said item is produced in a lot and the unique product item identifier's position on said good item is associated with the lot in which said good item was manufactured.
18. (Once Amended) The product of the process of claim 15.
19. (Twice Amended) The method of claim 15 wherein said visible electronically-readable package identifier which is placed on said good item or the packaging of said good item further identifies origin of manufacture.
20. (Twice Amended) A computer-assisted method of identifying a record owner of the product item, or part thereof, of claim 18 comprising:
 - obtaining the good item;
 - determining the invisible unique product item identifier encoded on said good item;
 - inputting said unique product item identifier into a data processor operatively connected with a data base housing purchaser identity information correlated to unique product item identifiers found on a plurality of goods items;
 - retrieving purchaser identity information correlated with said unique product item identifier in said data base;
 - determining the identity of the purchaser(s) of said good item from said purchaser identity information.
21. (Twice Amended) A processor-assisted method of recording the identity of a purchaser of a good an item, having an unique product item identifier thereon containing indicia.

information specifically identifying the particular ~~good item~~, purchased through a data processing telecommunications network comprising:

receiving over a data processing telecommunications network a digital data signal comprising digital information relating to the order of a good, the identity of the orderer of the good, and the address to which the orderer of the good desires the good to be transmitted, said digital data signal being transmitted from said orderer to a purveyor of said good;

transmitting from said purveyor, in response to said offerer's order, a digital data signal comprising a request for said good to a processor ~~at~~ located at a site at which such good is physically available as ~~a packaged product comprising said good, and a in a package surrounding said good, said package having a said package having~~
~~a package identifier in electronically-readable coded form correlateable with the an unique product item identifier said unique item identifier associated with the particular item comprising the packaged good, and comprising information identifying the manufacturer of said item and indicia specifically identifying said item;~~

receiving a digital data signal from form the site at which such good is physically available comprising digital information with respect to the package identifier; and

correlating in a database said package identifier digital information with said digital information pertaining to the identity of the offerer and the address to which the offerer desires the good to be transmitted.

22. (Cancelled) A computer-assisted purchase and sale method comprising:

~~accepting from a purchaser digital information identifying said purchaser, a contact address of said purchaser, and the good being purchased,~~

~~querying a relational database correlating said good with an identifier associated with said good and with one or more associated characteristics of said good;~~

querying a relational database which correlates associated characteristics of goods with offers by secondary purveyor(s) proffering good or services directed to such associated characteristics and a contact address of said secondary purveyors;

proffering the purchaser by way of said purchaser contact address, offers of good or services proffered by said secondary purveyor(s) which are related to associated characteristics of the purchased good;

contacting said secondary purveyor(s) by way of said secondary purveyor(s) contact address to inform said secondary purveyor(s) of the purchaser's response to said offer.

23. (Cancelled) The method of claim 22 wherein the identifier associated with the good being purchased is selected from the group consisting of: a unique product identifier, a unique package identifier, a product information identifier.

24. (Cancelled) The method of claim 22 wherein the processor assisted method entails use of a data processing telecommunication network.

25. (Cancelled) The method of claim 24 wherein the data processing telecommunication network is the Internet.

26. (Once Amended) A method for encoding concealed unique identifiers on products comprising:

directing one or more high energy electromagnetic waves at a material in a molten or semi-molten state such that the wave(s) substantially converge at a point within the material;

altering the convergence point of said high energy electromagnetic wave(s) such that the three-dimensional structure of the molten or semi-molten material is disrupted such that an unique identifier is formed;

using the solidified material in the construct of a product.

27. (Once Amended) The method of claim 26 wherein the molten or semi-molten material is a plastic.

28. (New) A process for ascertaining whether an item having a unique item identifier in electrically-readable coded form, said unique item identifier identifying the manufacturer of said item and comprising information specific to said item, is the same item that is identified by information in electronically-readable coded form on a medium, said process comprising the steps of:

a) comparing said unique item identifier on said item with the electronically-readable coded form information on said medium;

b) determining that said item having said unique item identifier is the same as said item identified on said medium if the unique item identifier favorably compares with the electronically-readable coded form information of step a.

29. (New) The product of claim 18 wherein said package identifier further comprises information pertaining to characteristics of the item.

30. (New) The product of claim 29 wherein said package identifier comprises information pertaining to the dimensions or features of the item.

31. (New) The product of claim 29 wherein said package identifier comprises information pertaining to add-ons associated with the item.
